

Application of Mark Gottlieb et al.  
Serial No.: 10/776,201  
Filed: February 12, 2004  
Reply to Office Action of May 3, 2006

### REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussions, is respectfully requested.

Claims 1 and 3-51 are currently pending in the application. Claim 2 has been canceled, claims 1, 3, 5, 14-18, 26, 32-34, 39-41, 44, 45, 47, 48 and 50 have been amended and no claims have been added by the present amendment. The changes to the claims are supported by the originally filed specification and do not introduce any new matter. For example, support for the changes to claim 1 can be found in original claim 2 and paragraphs [0027] and [0031]. Support for the changes to claims 48 and 50 can be found in paragraphs [0027] and [0031].

In the outstanding Office Action, claims 50 and 51 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; claims 1, 2, 30, 33-38, 41-42, 45-48 and 50 were rejected under 35 U.S.C. § 102(a)/(e) as being anticipated by U.S. Patent Publication No. 2003/0100326 (hereinafter "the '326 publication"); claims 1, 17, 21-23 and 31 were rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent Publication No. 2004/0203363 (hereinafter "the '363 publication"); claims 15-16, 24-29, 40, 43, 44, 49 and 51 were rejected under 35 U.S.C. § 103(a) as unpatentable over the '326 publication in view of at least one other reference; claims 2-4 were rejected under 35 U.S.C. § 103(a) as unpatentable over the '363 publication in view of at least one other reference.

In response to the rejection of claims 50 and 51 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, that rejection is now moot in light of the amendments to claim 50. Claim 50 has been amended to recite "A computer program implemented as computer code embedded within a computer readable memory of a digital communication device for identifying and communicating with other digital communication devices within a communication range." As such, the change addresses the allegation in the Office Action that "the claimed computer programs are ... [not] recorded on a computer-readable medium." Thus, this ground for rejection should be withdrawn.

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In response to the rejection of claims 1, 2, 30, 33-38, 41-42, 45-48 and 50 under 35 U.S.C. § 102(a)/(e) as being anticipated by the '326 publication, that ground for rejection is now moot in light of the amendments to claims 1, 48 and 50. Claim 1 has been amended to recite "a transmitter configured to transmit a control signal and a voice signal directly to other digital communication devices without utilizing fixed towers to re-transmit the control signal and a voice signal." Such a positively recited limitation is not taught by the '326 publication. Instead, in the '326 publication, as can be seen in Figure 1 and as is described in paragraph [0022], "The wireless infrastructure 103 supports the particular communication system 100 and, therefore, comprises one or more base stations (e.g., in a conventional system) or one or more base stations and one or more system controllers (e.g., in a trunking system)." (Emphasis added.) Thus, claim 1 and its dependent claims 30, 33-38, 41-42 and 45 are not anticipated by the '326 publication.

Similarly, claim 48 recites "transmitting identifying information as a control signal periodically directly to other digital communication devices without utilizing fixed towers to re-transmit the control signal." As discussed above with reference to claim 1, the '326 publication does not disclose such a limitation as the '326 publication utilizes base stations to facilitate communications between communications units. Thus, the rejection of claim 48 on this basis should be withdrawn.

Claim 50 likewise recites "a first computer code for transmitting identifying information as a control signal periodically directly to other digital communication devices without utilizing fixed towers to re-transmit the control signal." As discussed above with reference to claim 1, the '326 publication does not disclose such a limitation as the '326 publication utilizes base stations to facilitate communications between communications units. Thus, the rejection of claim 50 on this basis should be withdrawn.

In response to the rejection of the dependent claims under 35 U.S.C. § 103 based on the '326 publication and at least one other reference, it is respectfully submitted that the changes to the independent claims render moot those grounds for rejection. As was discussed for the independent claims, each of those claims is patentable over the applied references. Moreover,

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the Office Action has not alleged that the deficiency of the '326 publication is overcome by any of the references applied to the dependent claims. Thus, these grounds for rejection should be withdrawn.

In response to the rejection of claims 1, 17, 21-23 and 31 under 35 U.S.C. § 102(e) as being unpatentable over the '363 publication, that ground for rejection is rendered moot in light of the amendment to claim 1. Claim 1 has been amended to recite "a microphone configured to receive a voice communication from a user, wherein the user interface includes a transmit button, and the computational unit is configured to control the transmitter and the microphone to transmit the voice communication as the voice signal while the transmit button is selected by the user." Such a limitation is not taught by the '363 publication, as admitted in the rejection with respect to claim 2. Thus, claim 1 and its dependent claims are not anticipated by the '363 publication.

The Office Action also alleges that claim 2 is rendered obvious by the combination of the '363 publication and U.S. Patent Publication No. 2004/0015553 (hereinafter "the '553 publication"), and amended claim 1 will be addressed with reference to that rejection because of the changes to claim 1. While the Office Action admits that neither reference teaches all of the elements of original claim 2, the Office Action nonetheless alleges that "it would have been obvious for one of ordinary skill in the art at the time of the invention to combine [the '363 publication's] concept of informing buddies presence and the ['553 publication's] teaching of the push-to-talk button to make it easier for buddies, friends or members of a group to communicate with each other." However, the Office Action has not provided any evidence that this alleged "motivation" is found in the references themselves or in the art.

As shown in the '363 publication, the devices therein are expected to use short range communication because the user's are intended to be able to personally meet each other (such as when the users are supposed to be able to hear a particular ring tone). The Office Action has already alleged that the '363 publication can also transmit a personal ring signal 1308 as a voice signal. However, there is no disclosure of receiving voice from a microphone, as claimed.

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Instead, the personal ring signal 1308 appears to be pre-recorded binary data. This indicates that the '363 publication did not even identify that there was a problem to be solved such that voice messaging capabilities would be needed.

Moreover, the '553 publication is directed to communications using wireless carriers. Paragraph [0024] states "The terminals 100 communicate with at least one chat server complex 204 by wirelessly transmitting data to a corresponding wireless carrier's infrastructure 202. As known in the art, the wireless carrier infrastructures 202 comprise those elements necessary to support wireless communications with the terminals 100. Various service providers (such as Verizon or Sprint in the U.S., or Orange in Europe) build and maintain such infrastructures." Thus, the devices of the '553 publication are not communicating directly with each other but instead are communicating with the infrastructure through towers which then pass on the message(s). This increases the cost of an overall communication system as compared with directly communicating devices. It also prevents utilization of such devices in many areas (e.g., mountainous or wilderness areas) that are not supported by an "infrastructure." Absent evidence that one of ordinary skill would have actually been motivated to make the alleged combination, it is respectfully submitted that the combination is based on impermissible hindsight and claim 1 is nonobvious over the proposed combination of the '363 and '553 publications. In addition, as the Office Action has not alleged that the other references overcome the deficiencies identified with respect to the proposed combination of the '363 and '553 publications, the dependent claims of claim 1 are likewise patentable over the applied references.

Claim 48 recites "transmitting identifying information as a control signal periodically directly to other digital communication devices without utilizing fixed towers to re-transmit the control signal; [and] capturing a voice communication via a microphone and transmitting the voice communication as a voice signal while a transmit button is selected by a user." As discussed above with reference to claim 1, there is no tenable motivation to combine those references without relying on hindsight. Thus, Claim 48 and dependent claim 49 should be indicated as allowable.

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Claim 50 recites "a first computer code for transmitting identifying information as a control signal periodically directly to other digital communication devices without utilizing fixed towers to re-transmit the control signal; [and] a fourth computer code for capturing a voice communication via a microphone and transmitting the voice communication as a voice signal while a transmit button is selected by a user." As discussed above with reference to claim 1, there is no tenable motivation to combine those references without relying on hindsight. Thus, Claim 50 and dependent claim 51 should be indicated as allowable.

Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome and in condition for allowance. An early and favorable action to that effect is respectfully requested.

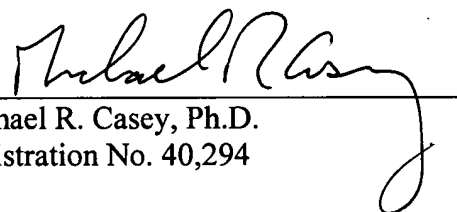
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